

Christopher J. DANEK et al.
Application No.: 09/436,455
Page 14

REMARKS

Amendment to Claims

Claims 1-13, 18-75, 77, and 79-94 are currently pending. Claims 14-17 were cancelled. Claim 38 was amended to correct an error. Claims 83-94 were added. Applicant believes that support for the added claims may be found in the specification and claims as originally filed.

35 U.S.C. §112 - I

The Office Action rejected claims 14-17 under 35 U.S.C. §112, 1st paragraph as containing subject matter which was not described in the specification.

Claims 14-17 are cancelled without prejudice.

35 U.S.C. §112 - II

The Office Action rejected claim 38 under 35 U.S.C. §112, 2nd paragraph as being indefinite. Claim 38 is amended herein.

35 U.S.C. §102 - I

The Office Action rejected claims 1-5, 18-30, 41, 45-47, 54, 57-59, 61-66, 70-71, and 74 under 35 U.S.C. §102(e) as being anticipated by Fleishman et al. (U.S. Patent no. 5,836,947). Applicant disagrees.

Claim 1 recites a temperature detecting element attached to one of said plurality of legs *wherein the temperature detecting element is in electrical communication with the leg*. The Office Action, citing to Fleishman, states that element 32 and its content are considered the legs. Fleishman teaches, starting on column 9, line 10, that there are “rigid electrode elements 30 arranged in a spaced apart, segmented relationship upon a flexible, electrically nonconductive sleeve 32 which surrounds the spline leg 22. The sleeve 32 is made [from] a polymeric electrically nonconductive material like polycylcylene or polyurethane.”

Christopher J. DANEK et al.
Application No.: 09/436,455
Page 15

Accordingly, it is impossible for the leg of the Fleishman device (as defined by the Office Action) to be in electrical communication with any temperature detecting element. As argued in previous Responses, Fleishman teaches various additional embodiments in which the leg cannot be in electrical communication with any temperature detecting element. Therefore, this limitation of claim 1 is simply not met.

Based solely on the preceding arguments, Fleishman fails to anticipate claim 1 and all claims ultimately dependent therefrom. For that reason alone, applicant believes the rejection should be withdrawn.

Apart from the above deficiency, applicant notes that Fleishman fails to anticipate claims 29, 61, 62, 63, and 64. Applicant is unable to find any teaching or suggestion in Fleishman regarding a thermocouple having first and second leads joined separately to a leg where each lead is in electrical communication with the leg, or a deployment member comprising a wire extending from the distal tip to a proximal portion of the device where the wire is configured to provide current to the energy transfer elements, or a temperature detecting element that is attached to a portion of the wire. More importantly, the Office Action fails to address these limitations.

In the absence of further clarification, applicant respectfully requests the withdrawal of this rejection.

35 U.S.C. §102 - II

The Office Action rejected claims 1-19, 21-28, 30, 35, 38, 44, 45, 47, 55-65, 70, 71, and 74 under 35 U.S.C. §102(e) as being anticipated by Jackson et al. (U.S. Patent no. 5,846,238). Applicant disagrees.

First, applicant reiterates that claim 1 recites a temperature detecting element attached to one of said plurality of legs *wherein the temperature detecting element is in electrical communication with the leg*. At the very least, this limitation is not taught or suggested by Jackson.

The Office Action states that, in Jackson, "the conductors are considered legs." However, the Office Action offers no support for this statement and applicant is unable to find any support for this statement. Instead, applicant notes that Jackson teaches an

Christopher J. DANEK et al.
Application No.: 09/436,455
Page 16

expandable-collapsible body, generally designated as, element 22 (see e.g., Jackson 7:33-8:50). This body 22 is covered by an electrically conducting shell, generally designated as element 24 (see e.g., Jackson 14:60-24:3).

There are additional shortcomings in equating the conductors of Jackson to the legs of applicant's claim. Claim 1 requires that each of the legs have a first end extending from a proximal joint and a second end terminating at a distal joint where the distal joint is adjacent to said distal tip. Applicant is unable to find, and the Office Action fails to provide any basis for corresponding proximal and/or distal joints, in Jackson.

In addition to the above, claim 1 requires a temperature detecting element attached to one of said plurality of legs wherein the temperature detecting element is in electrical communication with the leg. This limitation is simply not found in Jackson. Applicant reiterates that, in Jackson, any temperature element is connected to the shell 24 not to "legs" (e.g., 46, 146, etc.)

For the reasons above, Jackson fails to anticipate claim 1 and all claims ultimately therefrom.

In addition to the deficiencies of Jackson as applied to claim 1, Jackson also fails to teach or suggest the elements of, at least, claims 29, 61, 62, 63, and 64. Applicant is unable to find any teaching or suggestion in Jackson regarding a thermocouple having first and second leads joined separately to a leg where each lead is in electrical communication with the leg, or a deployment member comprising a wire extending from the distal tip to a proximal portion of the device where the wire is configured to provide current to the energy transfer elements, or a temperature detecting element that is attached to a portion of the wire. Again, the Office Action fails to address these limitations.

In the absence of further clarification, applicant respectfully requests the withdrawal of this rejection.

35 U.S.C. §103 - I

The Office Action rejected claims 1, 33, 34, 36-43, 67-70, 72-75, 77, and 79-82 under 35 U.S.C. §103(a) as being unpatentable over Jackson. Applicant disagrees.

Christopher J. DANEK et al.
Application No.: 09/436,455
Page 17

The Office Action fails to establish a proper *prima facie* case of obviousness. As discussed above, Jackson simply fails to teach or suggest all of the elements of claim 1 of applicant's invention. Accordingly, a proper *prima facie* case of obviousness is not established with regards to claim 1 and all claims dependent therefrom.

Furthermore, applicant traverses the Office Action's assertion of official notice. In particular, visualization systems, electrically conductive paint, formation of the legs from a single sheet of material, and additional optical and CCD equipment disputes that these items are well known in combination with the energy transfer apparatus as defined by applicant's claims. Applicant notes that the art cited by the Examiner pertains primarily to treatment of cardiac and other cardiovascular conditions. Applicant's device relates to an energy transfer apparatus for facilitating energy transfer into a mass of airway tissue. Accordingly, applicant believes that the additional features described above do not warrant 'official notice' without further documentation.

For the reasons provided above, applicant requests withdrawal of this rejection.

35 U.S.C. §103 - II

The Office Action rejected claims 1-14, 18-30, 38, 41, and 41-66 under 35 U.S.C. §103(a) as being unpatentable over Jackson in combination with Fleishman. Applicant disagrees. A proper *prima facie* case has not been established.

As discussed above, neither Jackson nor Fleishman teach or suggest all of the elements of applicant's claims. Accordingly, applicant requests withdrawal of this rejection.

35 U.S.C. §103 - III

The Office Action rejected claims 1, 30-32 under 35 U.S.C. §103(a) as being unpatentable over Jackson in combination with Kordis et al (U.S. Patent no. 5,647,870). Applicant disagrees. A proper *prima facie* case has not been established. Jackson fails to teach all of the elements of claim 1, the Office Action does not demonstrate how Kordis remedies this defect.

Accordingly, applicant requests withdrawal of this rejection.

Christopher J. DANEK et al.
Application No.: 09/436,455
Page 18

Interview Summary

Applicant's attorney wishes to express gratitude to the Examiner for the telephone interview of June 18, 2003. At this interview, the parties discussed Fleischman and Jackson, the references at issue in the 35 U.S.C. §102 rejections above. During the interview, the parties discussed the arguments presented above as well as additional arguments posed by the Examiner regarding the various embodiments in the Jackson reference and the thermocouple of the Fleischman reference. At the conclusion of the interview, the parties agreed that neither Fleischman nor Jackson anticipated claim 1. The Examiner indicated that the rejection involving these references would be withdrawn.

SUMMARY

Applicant believes all outstanding issues raised in the previous Office Action are addressed herein and that the claims are in condition for allowance. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at (650) 428-1600.

Respectfully submitted,


Sanjay S. Bagade
Reg. No. 42,280

Broncus Technologies Inc.
1400 N. Shoreline Blvd.
Mountain View, CA 94043
(650) 428-1600